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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,561	01/05/2004	Garret F. Geer	62870B	2405

109 7590 11/22/2005

THE DOW CHEMICAL COMPANY  
INTELLECTUAL PROPERTY SECTION  
P. O. BOX 1967  
MIDLAND, MI 48641-1967

EXAMINER
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HORTON, YVONNE MICHELE

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/751,561	<b>Applicant(s)</b> GEER ET AL.	
	<b>Examiner</b> Yvonne M. Horton	<b>Art Unit</b> 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 August 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-26 is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

Claims 1-13 are objected to because of the following informalities: the recitation that an element is "sufficient to" perform a certain function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

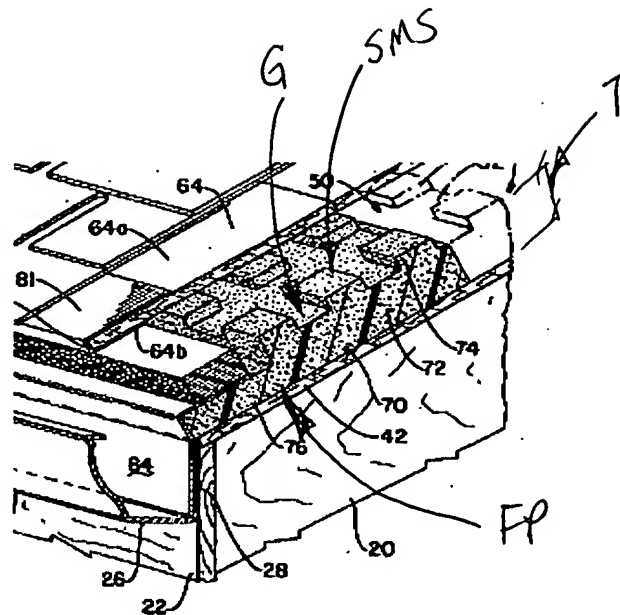
The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #5,473,847 to CROOKSTON in view of either US Patent #6,679,018 to GEORGEAU et al. or US Patent #3,879,508 to GILBERT. CROOKSTON discloses the use of a unitary roof rafter vent and insulation assembly including a generally flexible foam body (50) having a first planar surface (FP) spaced from a second major surface (SMS) by a thickness (T); wherein the second major surface (SMS) includes at least two grooves (G) such that the insulation assembly is sufficiently flexible to seal off the major surfaces (FP, SMS) from fluid communication, column 5, line 9-14, see below.

CROOKSTON discloses the basic claimed assembly except for explicitly detailing that

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his foam insulation material is polyolefin and except for detailing how flexible his material is. Both GEORGEAU et al. and GILBERT teaches the use of a polyolefin foam material (1,14); respectively, (GEORGEAU et al. column 4, line 22 and GILBERT column 3, line 2) for use in a roof structure. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the insulation material of CROOKSTON out of the polyolefin materials, as taught by either GEORGEAU et al. or GILBERT, in order to ensure that the material is sufficiently flexible for installation while also having a material that is substantially waterproof. Regarding the angle of bending, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select a known material suitable for the use intended as an obvious matter of design choice. For instance a polyolefin material would be more appropriate on sloped roofs as opposed to a flat roof because it is known for its ability to be flexible. In reference to claims 2 and 3, the materials of both GEORGEAU et al. and

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GILBERT are molded extrusions obviously having an olefin homo-polymer. Regarding claim 4, CROOKSTON discloses the use of a polystyrene material. In reference to claims 5-7 and 9-11, CROOKSTON, as modified by either GEORGEAU et al. or GILBERT, does not disclose the specified insulation thickness or degree of bending of the insulation; however, it too would have been an obvious matter of design choice to select the insulation thickness and degree of insulation to depend upon the use intended as an obvious matter of design choice. Also, the degree of flexibility of the insulation depends somewhat on the extent of select product thickness. Regarding claim 8, the insulation thickness (T) of CROOKSTON is less than or equal to the depth between the rafter and the roof deck, see above. In reference to claims 12 and 13, the second major surface (SMS) includes grooves (G) that are extruded/molded.

Claim 14 stands rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #5,473,847 to CROOKSTON in view of either US Patent #6,679,018 to GEORGEAU et al. or US Patent #3,879,508 to GILBERT, as applied to claim 1 above, and further in view of US Patent #5,867,956 to GREGORY, Jr. et al. CROOKSTON, as modified by either GEORGEAU et al. or GILBERT, discloses the basic claimed assembly except for the use of an exterior film. GREGORY, Jr. et al. teaches that it is known in the art to provide a roof insulation material (914) with an exterior film (12). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the insulation material of CROOKSTON, as modified by either GEORGEAU et al. or GILBERT, with the external film of GREGORY, Jr. et al. in order to further protect the roofing assembly.

***Allowable Subject Matter***

Claims 15-26 remain as being allowable.

***Response to Arguments***

Applicant's arguments filed 8/15/05 have been fully considered but they are not persuasive. Regarding the applicant's argument that CROOKSTON does not teach "placing" foam below the roof deck, the claim does not require the step of "placing". The claims are directed to an assembly "for sufficient use" in a certain situation and not to a method.

Further, the applicant is reminded that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Regarding the applicant's argument that CROOKSTON does not require a "flexible" member, but rather a "rigid" member, the examiner agrees in part. However, although CROOKSTON discloses "rigid", it is old and very much well known in the art for foams and more in particular for polystyrene or EPS foams, as taught by CROOKSTON, to have a desired or specified amount of flexibility. As stated earlier, most materials have some amount of flexibility with the requirement being governed by how the device or material is to be used. Further, the claim requires "sufficient flexibility", also as mentioned earlier, it is not clear what is intended by "sufficient".

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. GEORGEAU et al. and GILBERT are used with CROOKSTON to teach the use of polyolefin foam material, and are not cited for structural purposes.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne M. Horton whose telephone number is (571) 272-6845. The examiner can normally be reached on 6:30 am - 3:00 pm.

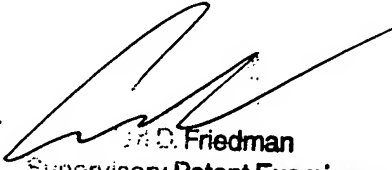
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on (571) 272-6842. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



YMH  
Examiner  
Art Unit 3635  
11/08/05



Carl D. Friedman  
Supervisory Patent Examiner  
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